<u>REMARKS</u>

The above Amendments and these Remarks are in reply to the Office Action mailed March 19, 2007. With the prior cancellation of claims 5, 11-26 and 32-37, and the current cancellation of claim 30, claims 1-4, 6-10, 27-29, 31 and 38 are presented herewith.

<u>Rejection of Claims 1-3 and 8-10 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting</u>

Claims 1-3 and 8-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 5, 7, 8, 10,14, 15, 23, 25, 28, 32, 34, 35, 37, 39, 41, 43, 45, 47, 49, 51, 53, 54, 56, 58, 60, 66, 68 and 69 of U.S. Patent No. 6,694,336 ("the '336 Patent"). Applicants respectfully submit that claims 1-3 and 8-10 are patentable over the above-cited claims of the '336 Patent. In particular, claim 1 as amended, and claims 2-3 and 8-10 dependent thereon, recite in part:

> (b)   generating a first copy of the media data in the personal information space;
> (c)   generating a second copy of the media data in the personal information space, the second version including an update not included in the first version;
> (d)   obtaining difference information comprising differences between the first copy of the media data and the second copy of the media data.

The claims of the '336 Patent have no such disclosure or suggestion. Nevertheless, in the event that this obviousness-type double patenting rejection is the sole remaining rejection, applicants would consider anew whether to file a terminal disclaimer.

<u>Rejection of Amended Claim 27 Under 35 U.S.C. §112</u>

Amended claim 27 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner indicated that there was not support in the specification for the term "system data store." Claim 27 has been amended to replace "system data store" with "application data store." This term has express support in the specification. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

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Rejection of Amended Claim 27 Under 35 U.S.C. §112

Amended claim 27 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner indicated that essential elements were omitted from the claims. The Examiner cites in support *In re Mayhew*. However, that case makes clear that elements need to be recited in the claims only where the applicant indicates, in the specification, that such elements are essential. The MPEP states in this regard:

> If the specification discloses that a particular feature or element is critical or essential to the practice of the invention, failure to recite or include that particular feature or element in the claims may provide a basis for a rejection based on the ground that those claims are not supported by an enabling disclosure. In re Mayhew. (MPEP, Section 2174).

In the present case, it is the Examiner, and not the applicant, that is asserting that these features are essential. The elements alleged by the Examiner to be essential are not in fact referred to as being essential anywhere in the specification. Applicant respectfully submits that these features are not essential to the claimed invention. While a working system may require a great many components to operate properly, a claimed invention may relate to only a portion of the overall working system. The essential element rule relates to the claimed invention, not the larger working system.

Based on the above, it is respectfully submitted that the invention as claimed is enabled, and it is respectfully requested that the rejection on these grounds be withdrawn.

Rejection of Amended Claims 27 and 30 Under 35 U.S.C. §112

Amended claims 27 and 30 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 27 has been amended in a way to overcome this rejection, and claim 30 has been canceled. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Rejection of Claims 1-3 and 7-10 Under 35 U.S.C. §103(a)

Claims 1-3 and 7-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,039,656 to Tsai et al. (hereinafter "Tsai") in view of U.S. Patent No. 7,020,704 to Lipscomb et al. ("Lipscomb"). Applicants wish to express their thanks to the Examiner for the thorough explanation offered with respect to Tsai and Lipscomb. While applicants do not entirely

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agree with the Examiner's characterization of the references, as explained hereinafter, applicants have amended claim 1, and claims 2-3 and 7-10 dependent thereon, in a way that is believed to further distinguish over the cited references.

Tsai discloses a synchronization system where data records are converted into a 32 bit hash using a known cyclic redundancy check (CRC) hash function. On the client side, data records are converted into a CRC number and stored in a first table within device 109 or PC 113. The table is then sent to a server upon a synch request. The server similarly stores data records, which are converted into a CRC number and stored within a second table. The received first table is compared against the stored second table to determine what data the device 109/PC 113 does not have.

Applicants' claim 1 as amended recites in part:

> (b) generating a first copy of the media data in the personal information space;
> (c) generating a second copy of the media data in the personal information space, the second version including an update not included in the first version;
> (d) obtaining difference information comprising differences between the first copy of the media data and the second copy of the media data.

These features are nowhere disclosed, taught or suggested in either Tsai or Lipscomb, or a combination of the two. While there are several distinctions between the claims as amended and the cited references, at a basic level, the comparison that goes on in Tsai is between a file that is received in a device (a first CRC table) and a file that is stored within the device (in a second CRC table). The received file is not generated within the device that performs the comparison. In particular, referring to Fig. 8, Tsai includes the "User CRC table" 131 including CRC numbers received from the user. Tsai also includes the "source data records" 135, which is processed by the CRC function to give the "Source CRC table" 143. The User CRC table 131 is compared against the Source CRC table 143 to identify what records the User CRC table does not have.

By contrast, the personal information space generates both the first and second copies of the files, representing the current media data and the media data prior to a change in the data. The difference information is obtained from these first and second copies of the media data. These features are not disclosed, taught or suggested in Tsai.

Moreover, neither the source data records 135, nor the Source CRC table 143 generated therefrom, are *copies* of the user data. As stated in Tsai at column 15, lines 36-44:

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Also illustrated within communication layer 129 is a block representing source data records 135 that are compiled and in some cases aggregated for a user. Block 135 will hereinafter be termed records 135 for the purpose of discussion. Records 135 may be internally sourced or created, or they may be obtained from other network sources already in the form of data records having a header and a body and which are ready for computation and comparison. Records 135 are analogous to block list 121 of FIG. 7B.

It is clear from the express disclosure of Tsai that Tsai does not determine differences between "the first copy of the media data and the second copy of the media data" as expressly recited in claim 1 as amended. In fact, the system of Tsai is identical to conventional synch systems, except that instead of transmitting a first set of whole records for comparison against a stored second set of whole records, Tsai first processes the records to convert the records into hashes in CRC tables to save communication bandwidth.

As the above-described limitations are not disclosed in the cited references, taken alone or in combination with each other, it is respectfully requested that the rejection of claims 1-3 and 7-10 under 35 U.S.C. §103(a) be withdrawn.

Rejection of Claims 4 and 38 Under 35 U.S.C. §103(a)

Claims 4 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai in view of Lipscomb and in further view of U.S. Publication No. 2002/0091785 to Ohlenbusch et al. (hereinafter "Ohlenbusch"). Claims 4 and 38 depend on independent claim 1. As indicated above, claim 1 recites limitations which are nowhere disclosed, taught or suggested in Tsai or Lipscomb, taken alone or together. In particular, the references fail to teach or suggest generating first and second copies of the media data in a personal information space and obtaining difference information comprising differences the first copy of the media data and the second copy of the media data. Ohlenbusch adds nothing to the teaching of those references in this regard.

It is therefore respectfully requested that the rejection of claims 4 and 38 under 35 U.S.C. §103(a) be withdrawn.

Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai in view of Lipscomb and in further view of U.S. Patent No. 6,812,961 to Parulski et al. ("Parulski").

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Claim 6 depends on independent claim 1. As indicated above, claim 1 recites limitations which are nowhere disclosed, taught or suggested in Tsai or Lipscomb, taken alone or together. In particular, the references fail to teach or suggest generating first and second copies of the media data in a personal information space and obtaining difference information comprising differences the first copy of the media data and the second copy of the media data. Parulski adds nothing to the teaching of those references in this regard.

It is therefore respectfully requested that the rejection of claim 6 under 35 U.S.C. §103(a) be withdrawn.

Rejection of Claims 27-32 Under 35 U.S.C. §103(a)

Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2001/0047393 to Arner et al. ("*Arner*") in view of *Tsai*.

Independent claim 27 recites in part:

> a device engine comparing at least one change in a record in said personal information store to said record in said application data store and generating an output file including at least one delta of digital media changed in the personal information store relative to the copy of the digital media in the system data store.

These features are not disclosed taught or suggested in the cited references. For example, the Examiner indicated that Arner teaches "holding a copy of a previous state of the digital medial in the information store" and cites to paragraph 102 of Arner. However, paragraph 102 is merely a hardware description and does not disclose or suggest the above recited feature. In view of these amendments, it is respectfully requested that the rejection of claims 27-32 under 35 U.S.C. §103(a) be withdrawn.

Rejection of Claims 27-31 Under 35 U.S.C. §103(a)

Claims 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,567,850 to Freishtat et al. (hereinafter "Freishtat") and "Official Notice".

As indicated above, independent claim 27 recites in part:

> a device engine comparing at least one change in a record in said personal information store to said record in said application data store and generating an output file including at least one delta of digital media changed in the personal information store relative to the copy of the digital media in the system data store.

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These features are not disclosed taught or suggested in the cited references. For example, the Examiner indicated that Col. 5, lines 1-65 of Freishtat teaches both the storing of a previous copy of the data and comparing a change in a record to the stored copy of the record. Applicants have carefully reviewed Col. 5, lines 1-65 of Freishtat, as well as the remaining portions of Freishtat, and can discern no such disclosure or teaching. In view of these amendments, it is respectfully requested that the rejection of claims 27-32 under 35 U.S.C. §103(a) be withdrawn.

Rejection of Claims 27-31 Under 35 U.S.C. §103(a)

Claims 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2004/0093342 to Arbo et al. (hereinafter "Arbo") in view of "Official Notice".

Arbo has an earliest effective prior art date of its parent provisional patent application of June 27, 2001. This date is after the filing date of the present invention. As such, Arbo is not prior art to the present invention, and it is respectfully requested that the rejection of claims 27-31 over Arbo be withdrawn.

Based on the above amendments and these remarks, reconsideration of the pending claims is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

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The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: September 20, 2007   By: /Brian I. Marcus/
                                                     Brian I. Marcus
                                                     Reg. No. 34,511

VIERRA MAGEN MARCUS & DENIRO LLP
575 Market Street, Suite 2500
San Francisco, California 94105
Telephone: (415) 369-9660
Facsimile: (415) 369-9665

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